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The § 103 Standard

To establish a prima facie case of obviousness, three basic criteria *must* be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).

Hence, when patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ("the central question is whether there is reason to combine [the] references," a question of fact drawing on the Graham factors).

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc., v. M3 Systems*,

1 *Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re*
2 *Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our
3 case law makes clear that the best defense against the subtle but powerful
4 attraction of a hindsight-based obviousness analysis is rigorous application of the
5 requirement for a showing of the teaching or motivation to combine prior art
6 references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed.
7 Cir. 1998) (there must be some motivation, suggestion, or teaching of the
8 desirability of making the specific combination that was made by the applicant);
9 *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)
10 ("teachings of references can be combined only if there is some suggestion or
11 incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v.*
12 *Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

13 The need for specificity pervades this authority. See, e.g., *In re Kotzab*,
14 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular
15 findings must be made as to the reason the skilled artisan, with no knowledge of
16 the claimed invention, would have selected these components for combination in
17 the manner claimed").

18 In view of the § 103 Standard set forth above, Applicant respectfully
19 submits that the Office has not established a *prima facie* case of obviousness.
20

21 **The Claims**

22 **Claim 1** recites a software architecture for a distributed computing system
23 comprising:
24

- 25 • an application configured to handle requests submitted by remote devices over a network; and

- an application program interface to present functions used by the application to access network and computing resources of the distributed computing system, the application program interface comprising various types related to constructing user interfaces.

In making out the rejection of this claim, the Office argues that Shannon discloses all of the subject matter of this claim except for an application program interface comprising various types related to constructing user interfaces. The Office then relies on Sun and argues that it teaches an API comprising various types related to constructing user interfaces. The Office then reasons that the combination of Shannon and Sun would render the subject matter of this claim obvious, and states the following as a motivation to combine the references: “because Shannon’s system is based on J2SE and Sun teaches J2SE is used to construct the client side which includes the user interface.”

Applicant respectfully disagrees and submits that the Office has not established a *prima facie* case of obviousness.

Without addressing the substantive features of the cited references (which Applicant submits do not teach all features of the claimed subject matter), the Office’s stated motivation to combine these references is misplaced and does not rise to the level of supporting a *prima facie* case of obviousness. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. See, e.g. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the present case, the Office’s attempt at a “convincing line of

1 reasoning” is to state simply that “Shannon’s system is based on J2SE and Sun
2 teaches J2SE issued to construct the client side which includes user interface.”
3 As noted above, particular findings must be made as to the *reason* the skilled
4 artisan, *with no knowledge of the claimed invention*, would have selected these
5 components for combination in the manner claimed. *In re Kotzab*, 217 F.3d
6 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

7 Applicant respectfully submits that the Office has not made particular
8 findings as to the reason the claimed subject matter would be obvious in view of
9 the cited references.

10 Additionally, and as an aside, the Office has provided a paper, available at
11 the following link:

12 <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm>
13

14 that describes proper and improper rejections made under §103(a).
15 Particularly instructive is an example that appears in Section V of the paper
16 illustrating an improper §103(a) rejection which is based upon hindsight in view
17 of a general motivation statement. This example is reproduced below in its
18 entirety for the Office’s convenience:

19 **V. Examples of Improper Rejection under 35 U.S.C. 103**

20 Example 17: Improper rejection based upon hindsight - general
21 motivation statement.

22 **a. The claimed invention**

23
24 The invention is drawn to a smart card containing a tracking
25 mechanism, which tracks shopping preferences of consumers by recording
the type, quantity, and dates of purchase for a pre-selected group of

1 products. The smart card is useful in a system and method for introducing
2 new and alternative products that are of the same type as products
3 normally purchased by the shopper. The smart card records the shopper's
4 purchases and submits an automatic notification to the shopper when a
5 quantity threshold is achieved for the pre-selected products. This
6 notification will encourage the consumer to consider alternative products
7 by providing the consumer incentives, such as a pricing discount, to
8 purchase an alternative product.

9
10
11 **Claim 1:**

12 A method for using a smart card in a marketing analysis program
13 designed to introduce new products, the method comprising the steps of:

14 storing product information on the smart card when said products
15 are purchased by a consumer wherein said information including type,
16 quantity and dates of the product purchased;

17 identifying for each product a threshold for each of said type,
18 quantity and dates of products purchased;

19 determining an incentive for an alternative product based on said
20 threshold; and

21 automatically notifying said consumer when said threshold is
22 reached for a given product identified on the smart card and providing the
23 consumer with said incentive, whereby the incentive encourages the
24 consumer to consider alternative products.

25 **b. Evidence**

Reference A discloses smart card that tracks consumer preferences by recording the type, quantity, and dates of purchase of pre-selected products to determine trends in consumer purchases. The smart card is periodically read by a scanner to determine its contents for market analysis. In return for using the smart card and participating in the marketing program, the user is provided with free product coupons for products that are normally purchased by the shopper.

Reference B discloses a traditional consumer incentive program that provides coupons for the purchase of named products based upon the consumer's purchase of those same products to promote customer loyalty.

c. Poor statement of the rejection

1 Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over
2 Reference A in view of Reference B. Reference A discloses the
3 conventional use of a smart card to track consumer preferences and
4 provide incentives. However, Reference A does not disclose the automatic
5 notification to consumer providing incentives. Reference B discloses
6 providing incentives to consumers to purchase the desired products. It
7 would have been obvious to combine Reference A's smart card with
8 Reference B's incentive to consumers because the combination would
9 allow Reference A's smart card to be more efficient.

10 d. Analysis

11 The motivation, improve efficiency, is too general because it could cover
12 almost any alteration contemplated of Reference A and *does not address why*
13 *this specific proposed modification would have been obvious*. Additionally,
14 there is nothing in either of references that would suggest automatically notifying
15 the consumer when reaching a threshold nor is there anything in either reference
16 that would suggest the notifying step. Finally, although Reference B teaches a
17 traditional coupon scheme to promote customer loyalty, there is no suggestion,
18 other than applicant's disclosure, to employ this scheme to promote the
19 introduction of new and alternative products. **The rejection is improper.**

20 In this case, the example rejection attempted to at least provide a reason
21 for combining the references—even though that reason was too general, and did
22 not address *why* a specific proposed modification would have been obvious.

23 In the present rejection, the Office has not even stated a reason why the
24 claimed subject matter would be obvious other than that Shannon's system is
25 based on J2SE and Sun teaches J2SE is used to construct the client side which
includes the user interface.

Applicant submits that the Office has failed to establish a *prima facie* case
of obviousness for at least the reason that the Office has failed to provide a
specific reason why the claimed subject matter would be obvious in view of the
cited references. Accordingly, Applicant traverses the Office's rejection.

1 **Claims 2-4** depend from claim 1 and are allowable as depending from an
2 allowable base claim. In addition, given the Office's failure to establish a *prima*
3 *facie* case of obviousness, the Office's reliance on Flanagan in making out the
4 rejection of claim 2 is not seen to add anything of significance.

5 **Claim 5** recites an application program interface embodied on one or more
6 computer readable media, comprising: multiple types related to constructing user
7 interfaces, the types comprising classes, interfaces, delegates, structures and
8 enumerations.

9 In making out the rejection of this claim, the Office argues that Sun
10 discloses all of the subject matter of this claim except for types comprising
11 delegates, structures and enumerations. The Office then relies on Flanagan and
12 argues that it teaches delegates and enumerations and argues that it would be
13 obvious to combine Sun and Flanagan to render the claimed subject matter
14 obvious "because Flanagan clearly show[s] the description of the API supported
15 by Sun." In addition, the Office argues that although Sun does not teach
16 structures, it would have been obvious that structures are supported because Sun
17 supports abstract class which function as structure.

18 Applicant does not understand the Office's line of reasoning and submits
19 that the Office has failed to establish a *prima facie* case of obviousness.

20 Without addressing the substantive features of the cited references (which
21 Applicant submits do not teach all features of the claimed subject matter), the
22 Office's stated motivation to combine these references is misplaced and does not
23 rise to the level of supporting a *prima facie* case of obviousness. To support the
24 conclusion that the claimed invention is directed to obvious subject matter, either
25 the references must expressly or impliedly suggest the claimed invention or the

1 examiner must present a convincing line of reasoning as to why the artisan would
2 have found the claimed invention to have been obvious in light of the teachings of
3 the references. See, e.g. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. &
4 Inter. 1985). In the present case, the Office's attempt at a "convincing line of
5 reasoning" is to state simply that "because Flanagan clearly show the description
6 of the API supported by Sun."

7 As noted above, particular findings must be made as to the *reason* the
8 skilled artisan, *with no knowledge of the claimed invention*, would have selected
9 these components for combination in the manner claimed. *In re Kotzab*, 217 F.3d
10 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

11 Applicant respectfully submits that the Office has not made particular
12 findings as to the reason the claimed subject matter would be obvious in view of
13 the cited references. Accordingly, Applicant traverses the Office's rejection.

14 **Claims 6-15** depend from claim 5 and are allowable as depending from an
15 allowable base claim.

16 **Claim 16** recites a distributed computer software architecture, comprising:

- 17
- 18 • one or more applications configured to be executed on one or more
19 computing devices, the applications handling requests submitted
20 from remote computing devices;
 - 21 • a networking platform to support the one or more applications; and
 - 22 • an application programming interface to interface the one or more
23 applications with the networking platform, the application
24 programming interface comprising various types related to
25 constructing user interfaces.

23 In making out the rejection of this claim, the Office argues that Shannon
24 discloses all of the subject matter of this claim except for an application program
25

1 interface comprising various types related to constructing user interfaces. The
2 Office then relies on Sun and argues that it teaches an API comprising various
3 types related to constructing user interfaces. The Office then reasons that the
4 combination of Shannon and Sun would render the subject matter of this claim
5 obvious, and states the following as a motivation to combine the references:
6 “because Shannon’s system is based on J2SE and Sun teaches J2SE is used to
7 construct the client side which includes the user interface.”

8 Applicant respectfully disagrees and submits that the Office has not
9 established a *prima facie* case of obviousness.

10 Without addressing the substantive features of the cited references (which
11 Applicant submits do not teach all features of the claimed subject matter), the
12 Office’s stated motivation to combine these references is misplaced and does not
13 rise to the level of supporting a *prima facie* case of obviousness. To support the
14 conclusion that the claimed invention is directed to obvious subject matter, either
15 the references must expressly or impliedly suggest the claimed invention or the
16 examiner must present a convincing line of reasoning as to why the artisan would
17 have found the claimed invention to have been obvious in light of the teachings of
18 the references. See, e.g. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. &
19 Inter. 1985). In the present case, the Office’s attempt at a “convincing line of
20 reasoning” is to state simply that “Shannon’s system is based on J2SE and Sun
21 teaches J2SE issued to construct the client side which includes user interface.”
22 As noted above, particular findings must be made as to the *reason* the skilled
23 artisan, *with no knowledge of the claimed invention*, would have selected these
24 components for combination in the manner claimed. *In re Kotzab*, 217 F.3d
25 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

1 Applicant respectfully submits that the Office has not made particular
2 findings as to the reason the claimed subject matter would be obvious in view of
3 the cited references. Accordingly, the Office has not established a *prima facie*
4 case of obviousness and this claim is allowable.

5 **Claims 17-27** depend from claim 16 and are allowable as depending from
6 an allowable base claim.

7 **Claim 28** recites a computer system including one or more
8 microprocessors and one or more software programs, the one or more software
9 programs utilizing an application program interface to request services from an
10 operating system, the application program interface including separate commands
11 to request services comprising services related to constructing user interfaces.

12 In making out the rejection of this claim, the Office argues that Shannon
13 discloses all of the subject matter of this claim except for an application program
14 interface including separate commands to request services comprising services
15 related to constructing user interfaces. The Office then relies on Sun and argues
16 that it teaches an API comprising various types related to constructing user
17 interfaces. The Office then reasons that the combination of Shannon and Sun
18 would render the subject matter of this claim obvious, and states the following as
19 a motivation to combine the references: "because Shannon's system is based on
20 J2SE and Sun teaches J2SE is used to construct the client side which includes the
21 user interface."

22 Applicant respectfully disagrees and submits that the Office has not
23 established a *prima facie* case of obviousness.

24 Without addressing the substantive features of the cited references (which
25 Applicant submits do not teach all features of the claimed subject matter), the

1 Office's stated motivation to combine these references is misplaced and does not
2 rise to the level of supporting a *prima facie* case of obviousness. To support the
3 conclusion that the claimed invention is directed to obvious subject matter, either
4 the references must expressly or impliedly suggest the claimed invention or the
5 examiner must present a convincing line of reasoning as to why the artisan would
6 have found the claimed invention to have been obvious in light of the teachings of
7 the references. See, e.g. *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. &
8 Inter. 1985). In the present case, the Office's attempt at a "convincing line of
9 reasoning" is to state simply that "Shannon's system is based on J2SE and Sun
10 teaches J2SE issued to construct the client side which includes user interface."
11 As noted above, particular findings must be made as to the *reason* the skilled
12 artisan, *with no knowledge of the claimed invention*, would have selected these
13 components for combination in the manner claimed. *In re Kotzab*, 217 F.3d
14 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

15 Applicant respectfully submits that the Office has not made particular
16 findings as to the reason the claimed subject matter would be obvious in view of
17 the cited references. Accordingly, the Office has not established a *prima facie*
18 case of obviousness and this claim is allowable.

19 **Claim 29** recites a method, comprising:

- 20
- 21 • managing network and computing resources for a distributed
22 computing system; and
 - 23 • exposing a set of functions that enable developers to access the
24 network and computing resources of the distributed computing
25 system, the set of functions comprising functions to facilitate
construction of user interfaces.

1 In making out the rejection of this claim, the Office simply indicates “see
2 rejection of claim 1 above.” For the reasons stated above with respect to claim 1
3 and the Office’s failure to articulate an appropriate motivation to combine the
4 cited references, the Office has failed to establish a *prima facie* case of
5 obviousness and this claim is allowable.

6 **Claim 30** depends from claim 29 and is allowable as depending from an
7 allowable base claim.

8 **Claim 31** recites a method, comprising creating a namespace with
9 functions that enable drawing and construction of user interfaces, the name space
10 defining classes, interfaces, delegates, structures and enumerations.

11 In making out the rejection of this claim, the Office does not appear to take
12 a position with respect to its patentability in view of the cited references (See,
13 Office Action, Page 9, ¶ 32. It appears that the Office may have intended to
14 reject this claim in a similar manner as was used to reject claim 5 above. If this is
15 the case, then for the reasons set forth above with respect to the Office’s failure to
16 articulate a proper motivation to combine the cited references, this claim is
17 allowable.

18 **Claims 32-40** depend from claim 31 and are allowable as depending from
19 an allowable base claim.

20 21 **Conclusion**

22 Applicant respectfully submits that the Office has failed to establish a
23 *prima facie* case of obviousness for the reasons set forth above. Applicant
24 respectfully requests a Notice of Allowability be issued forthwith. If the next
25 anticipated action is to be anything other than issuance of a Notice of

1 Allowability, Applicant respectfully requests a telephone call for the purpose of
2 scheduling an interview.

3
4 Respectfully submitted,

5
6 Dated: 4/1/09

7 By: 

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